

REMARKS

In the final Office Action, the Examiner objects to claims 1 and 19 due to informalities; rejects claims 1-4, 8-11, 19, and 20 under 35 U.S.C. § 102(e) as anticipated by GUTHRIE (U.S. Patent No. 6,266,681); rejects claims 5 and 6 under 35 U.S.C. § 103(a) as unpatentable over GUTHRIE in view of PACIFICI et al. (U.S. Patent No. 6,230,171); rejects claims 17, 18, and 22 under 35 U.S.C. § 103(a) as unpatentable over GUTHRIE in view of KANEVSKY (U.S. Patent No. 6,300,947), and further in view of CHENNAPRAGADA et al. (U.S. Patent No. 6,701,368); and rejects claim 7 under 35 U.S.C. § 103(a) as unpatentable over GUTHRIE in view of PACIFICI et al., and further in view of KANEVSKY.

By the present amendment, Applicants propose canceling claims 5 and 11 without prejudice or disclaimer and amending claims 1, 4, 6, 7, 19, and 20 to improve form. Claims 1-4, 6-10, 17-20, and 22 would remain pending following the entry of the present amendment.

Claims 1 and 19 stand objected due to an informality. In particular, the Examiner alleges that the use of the phrase "remote server" is in contrast to the specification and makes the claim unclear (final Office Action, pg. 2). Applicants propose amending claims 1 and 19 to address the Examiner's concerns. Accordingly, Applicants request that the objection to claims 1 and 19 be reconsidered and withdrawn.

Claims 1-4, 8-11, 19, and 20 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by GUTHRIE. Applicants propose canceling claim 11 via the present

amendment thereby rendering the rejection of that claim moot. Applicants respectfully traverse this rejection with respect to the remaining claims, as now amended.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. GUTHRIE does not disclose or suggest at least one feature recited in claims 1-4, 8-10, 19, and 20.

For example, amended independent claim 1 is directed to a method for inserting a toolbar into a webpage. The method includes receiving a webpage at a server to be delivered to a client; inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, the toolbar including at least one link to a resource; and delivering the webpage including the executable script to the client. GUTHRIE does not disclose or suggest this combination of features.

For example, GUTHRIE does not disclose or suggest inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser. This feature is similar to the feature that was previously recited in claim 5. With respect to that claim, the Examiner admits that GUTHRIE does not disclose the above feature and relies on col. 5, lines 22-38, of PACIFICI et al. for allegedly disclosing this feature (final Office Action, pp. 5-6). Applicants respectfully disagree.

At col. 5, lines 22-38, PACIFICI et al. discloses:

Since HTML documents can be composed of multiple frames or windows, a markup agent 412 is associated with each frame. The agent has several

responsibilities within its frame including:

if the user is the floor holder and is in one of the active markup modes, then all relevant mouse and keyboard input events are captured as shown at 416;

the captured input events are translated into corresponding markup actions, i.e., composition of new dynamic HTML components, shown at 420;

markup messages are composed as shown at 418, and passed to the client-side manager together with a unique identifier for the frame, in order to be transferred to other participants;

on the receiving participant's side, the received messages are parsed as shown at 424 and the corresponding markup actions are performed shown at 420.

This section of PACIFICI et al. merely discloses that each frame or window of an HTML document may be associated with a markup agent 412. This section of PACIFICI et al. in no way discloses or suggests inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, as required by amended claim 1. Moreover, PACIFICI et al. does not disclose that the dynamic HTML components are toolbars.

Even assuming, for the sake of argument, that the above section of PACIFICI et al. could reasonably be construed to disclose the above feature of claim 1, Applicants submit that one skilled in the art would not have been motivated to combine this alleged teaching of PACIFICI et al. with the disclosure of GUTHRIE, absent impermissible hindsight. With respect to motivation, the Examiner alleges "[o]ne would have been motivated to have this as there is a need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames" and points to col. 3,

lines 1-29, of GUTHRIE for support (final Office Action, pg. 6). Applicants respectfully disagree.

Applicants submit that the Examiner's allegation with respect to motivation is merely conclusory. The Examiner has not reasonably explained why one skilled in the art would seek to modify the system of GUTHRIE to include PACIFICI et al.'s alleged teaching of inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser. The Examiner's allegation that such a modification to the GUTHRIE system would allow "a user to be able to incorporate add-on components in a webpage including webpages with multiple frames" is unsupported by the GUTHRIE disclosure since GUTHRIE already discloses the ability to incorporate add-on components in a webpage (see col. 3, lines 22-25, and Fig. 3). Therefore, it is unclear how the Examiner can allege that modifying the GUTHRIE system to include the alleged feature of PACIFICI et al. would allow GUTHRIE to perform a function that GUTHRIE already performs.

Since the Examiner has not logically explained why one skilled in the art would have been motivated to modify the system of GUTHRIE to include PACIFICI et al.'s alleged teaching of inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, a *prima facie* basis for denying patentability has not been established.

For at least the foregoing reasons, Applicants submit that claim 1 is not anticipated by GUTHRIE or rendered obvious by the combination of GUTHRIE and PACIFICI et al.

Claims 2-4 and 8-10 depend from claim 1. Therefore, these claims are not anticipated by GUTHRIE or rendered obvious based on the combination of GUTHRIE and PACIFICI et al. for at least the reasons given above with respect to claim 1.

Amended independent claim 19 recites features similar to features given above with respect to claim 19. Therefore, claim 19 is not anticipated by GUTHRIE or rendered obvious based on the combination of GUTHRIE and PACIFICI et al. for reasons similar to reasons given above with respect to claim 1.

Claim 20 depends from claim 19. Therefore, this claim is not anticipated by GUTHRIE or rendered obvious based on the combination of GUTHRIE and PACIFICI et al. for at least the reasons given above with respect to claim 19.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over GUTHRIE in view of PACIFICI et al. Applicants propose canceling claim 5 via the present amendment thereby rendering the rejection of that claim moot. Applicants respectfully traverse this rejection with respect to the remaining claim.

Claim 6 depends from claim 1. As set forth above, GUTHRIE and PACIFICI et al., whether taken alone or in any reasonable combination, do not disclose or suggest the combination of features recited in Applicants' claim 1. Therefore, claim 6 is patentable over GUTHRIE and PACIFICI et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

Claims 17, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over GUTHRIE in view of KANEVSKY, and further in view of CHENNAPRAGADA et al. Applicants respectfully traverse.

Independent claim 17 is directed to a computer readable medium that includes at least computer program code for determining whether a toolbar should be displayed in one or more frames of a webpage. The computer readable medium includes computer program code for determining whether an activation script for rendering a toolbar is within HTML code for each frame of a webpage having more than one frame; computer program code for determining a size of each frame of the webpage using the HTML code; and computer program code for rendering the toolbar in each of the frames of the webpage when the size of a frame exceeds a threshold size and not rendering the toolbar in each of the frames of the webpage when the size of a frame does not exceed the threshold size. GUTHRIE, KANEVSKY, and CHENNAPRAGADA et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, GUTHRIE, KANEVSKY, and CHENNAPRAGADA et al. do not disclose computer program code for rendering the toolbar in each of the frames of the webpage when the size of a frame exceeds a threshold size and not rendering the toolbar in each of the frames of the webpage when the size of a frame does not exceed the threshold size. The Examiner relies on GUTHRIE for allegedly disclosing computer program code for rendering the toolbar in each of the frames of the webpage and points to col. 6, lines 41-56, for support (final Office Action, pg. 7). Applicants disagree.

At the outset, it is unclear as to how the Examiner can admit, on the one hand, that GUTHRIE does not disclose the ability to render a toolbar in each frame of a webpage (see final Office Action, pg. 5) and then, on the other hand, allege that GUTHRIE

discloses the very feature that the Examiner admits GUTHRIE does not disclose.

Contrary to the Examiner's allegation with respect to claim 17, Applicants submit that GUTHRIE does not disclose or suggest the ability to render a toolbar in each frame of a webpage.

GUTHRIE specifically discloses a webpage including a number of frames 306-308 (Fig. 3). GUTHRIE specifically discloses that the system ensures that only one instance of injectable component 305, which the Examiner alleges corresponds to the recited toolbar, is generated and displayed in browser application window 303 (col. 5, lines 63-67), which includes, as illustrated in Fig. 3, 3 separate frames. This section of GUTHRIE clearly contradicts the Examiner's position that GUTHRIE's system is able to render a toolbar in each frame of a webpage each frame 306-308.

At col. 6, lines 41-56, GUTHRIE discloses:

The injected code 408, which is injected into the HTTP-response 409 by interceptor code module 402, contains instructions that specifically cause the WEB browser 401 to conditionally insert HTML tag statements (HTML code) into the document 407 when the browser executes the injected code. The HTML code is used by the WEB browser 401 to generate and display an instance of the injectable component. The conditions are determined by the injected code itself. In one embodiment, the injected code is written to only insert these HTML tag statements when the component is not already being displayed.

This section of GUTHRIE discloses that HTML tag statements can be conditionally inserted into document 407 when the browser executes the injected code. This section of GUTHRIE in no way discloses or suggests the ability to render a toolbar in each frame of a webpage, as required by claim 17. The disclosures of KANEVSKY and

CHENNAPRAGADA et al. do not remedy the above deficiency in the disclosure of GUTHRIE.

For at least the foregoing reasons, Applicants submit that claim 17 is patentable over GUTHRIE, KANEVSKY, and CHENNAPRAGADA et al., whether taken alone or in any reasonable combination.

Claims 18 and 22 depend from claim 17. Therefore, these claims are patentable over GUTHRIE, KANEVSKY, and CHENNAPRAGADA et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 17.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over GUTHRIE in view of PACIFICI et al., and further in view of KANEVSKY. Applicants respectfully traverse this rejection.

Claim 7 depends from claim 1. Applicants submit that the disclosure of KANEVSKY does not remedy the deficiencies in the disclosures of GUTHRIE and PACIFICI et al. set forth above with respect to claim 1. Therefore, claim 7 is patentable over GUTHRIE, PACIFICI et al., and KANEVSKY, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

In view of the foregoing amendment and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims. Applicants respectfully submit that the above claim amendments be entered. The claim amendments do not raise new issues or require a further search of the art since the combination of features were already present in the claims, as examined.

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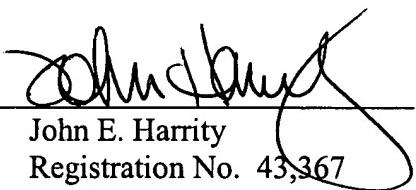
Moreover, the present amendment reduces the issues for appeal. Therefore, Applicants respectfully request that the present amendment be entered and that the outstanding claims be allowed.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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